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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,772	03/26/2004	Andrew Stark	3080.BDG	9608
<div>7590 Charles W. Almer National Starch and Chemical 10 Findeme Avenue Bridgewater, NJ 08807</div>				
<div>EXAMINER NILAND, PATRICK DENNIS</div>				
<div>ART UNIT 1796</div>				
<div>PAPER NUMBER</div>				
<div>MAIL DATE 05/12/2009</div>				
<div>DELIVERY MODE PAPER</div>				

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/810,772

**Applicant(s)**

SLARK ET AL.

**Examiner**

Patrick D. Niland

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22-34 is/are allowed.
- 6) ☒ Claim(s) 35-37 is/are rejected.
- 7) ☒ Claim(s) 35-37 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

1. The amendment of 2/11/09 has been entered. Claims 22-37 are pending.
2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 35-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. It is unclear what is intended by "mixtures" of the instant claim 35. There is not antecedent basis for "mixtures" in claim 35 nor claim 22. It is unclear what other mixture than the one specified in claim 22 is intended by "mixtures".

B. It is unclear what is intended by the instant claims 35-37. The claim from which claims 35-37 depends, claim 22, recites a mixture comprising the urethane diol and polyether polyol or polyester polyol. Claims 35-37 redefine the mixture and appear to exclude the urethane diol in claims 35-37 and the polyether or polyester polyol in claim 36. It is unclear how the newly recited mixture has antecedent basis from the mixture of claim 22 therefore. It does not appear that "further comprises" is intended by the language of new claims 35-37 given that this language is used in the instant claim 26, for example, and not in new claims 35-37.

4. Claims 35-37 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

A. It is unclear what is intended by the instant claims 35-37. The claim from which claims 35-37 depends, claim 22, recites a mixture comprising the urethane diol and polyether

polyol or polyester polyol. Claims 35-37 redefine the mixture and appear to exclude the urethane diol in claims 35-37 and the polyether or polyester polyol in claim 36. It is unclear how the newly recited mixture has antecedent basis from the mixture of claim 22 therefore. It does not appear that "further comprises" is intended by the language of new claims 35-37 given that this language is used in the instant claim 26, for example, and not in new claims 35-37.

This changing of the meaning of the mixture of claim 22 in claims 35-37 does not further limit the subject matter of previous claim 22. Claims 35-37 therefore do not meet the requirements of the above rule.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 1796

/Patrick D Niland/  
Primary Examiner  
Art Unit 1796